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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/808,456 | 03/25/2004 | John B. McAdams | 315-101P-WLK | 4857 |

7590 03/30/2006

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| EXAMINER |
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SUHOL, DMITRY

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| ART UNIT | PAPER NUMBER |
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3725

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/808,456 | MCADAMS ET AL. | |
| | Examiner | Art Unit | |
| | Dmitry Suhol | 3725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson et al '656 in view of Swartz et al '418. Lemelson discloses a device for scanning and audio generation (as required by claims 18 and 20) from printed material containing most of the claimed elements, including with reference to claims 1, 17 and 19, a support medium including as least one page (book 2), printed matter including normal-sized printed text configured for a sighted person printed on at least on page (pictures and written text disclosed in col. 3, line 61), a bar code printed on the page (bar code 4), the bar code oriented parallel to an edge of at least one page and located within the margin of the page (figures 1 and 2 and col. 3, lines 59-61), the bar code emulating the printed text (col. 7, lines 37-41) and configured to be scanned by a hand held scanner (60). A machine reading device including a hand held scanner, as required by claims 1, 17 and 19, is shown as scanning device 60 in figure 4 whose function is described in col. 6, lines 32-41. The scanner being provided with at least one guiding edge for guiding the scanner while scanning the bar code, as required by claim 2, is read onto the edge which guides the scanner along the edges 14 of cutout 12. The bar

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code being configured such that it is read top to bottom, as required by claim 3, is shown in figures 1 and 2. A right and left guiding edges, as required by claim 4, are read onto the right and left edge portions that contact the right and left edges 14 of member 8. The scanner including a wider upper body scanning portion (portion 62 where it is considered wide due to flange portion 39) provided with a left guiding edge and a right guiding edge (the right and left edge portions that contact the right and left edges 14 of member 80 and a thinner lower body gripping portion (gripping body 60 which is thinner than flange 39), as required by claim 5, is shown in figure 4. The medium being a book, as required by claim 6, is shown as book 2 in figures 1 and 2. The relationship of the bar code and printed matter as required by claims 8, 10, 18 and 20 is described in col. 7, lines 37-41. The relationship of the bar code and at least one picture, as required by claim 9, is shown in figures 1 and 2.

Lemelson fails to explicitly teach that his bar code is a Braille linear high density multidimensional type barcode (2-D as required by claim 15) as required by claims 1, 17 and 19. However, Swartz discloses a device which converts bar code data into audible sounds (used for blind people col. 4, lines 59-62) which teaches that it is known to use a variety of bar codes including a Braille type linear high density multidimensional type barcode (col. 4, lines 27+). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have utilized a Braille type linear high density multidimensional type barcode (including a 2-D bar code) since the use of a particular type bar code would only depend on the amount of information to be stored and conveyed, especially since Lemelson clearly states that he envisions for his device

to be utilized by the handicapped (col. 1, lines 57-61). Furthermore, the specific bar code dimensionality is considered to be a design choice in that applicants disclose that the bar code used in their invention may be of any type desired (page 12, lines 12-14 and page 18, lines 6-8).

Regarding the positioning of the Braille type bar code, as required by claims 1-5, 7, 12-14, and the additional printed matter as required by claim 1. It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to place the Braille type bar code in any location on the page since it would only depend on the intended use of the assembly and the desired information to be displayed and since Lemelson states that the bar code of his invention may be placed in rows or columns anywhere on the pages provided that it does not interfere with the printed text. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of placement for the Braille code does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. Braille bar code location or additional printed matter) and the substrate (support medium) which is required for patentability. Additionally the location of the placement of the Braille bar code is considered to be a design choice since applicants do not disclose any

advantage or criticality for such placement and it would appear that the device would work equally well no matter the positioning of the bar code (see applicants specification page 15, lines 15-20).

Regarding the dimensionality of the Braille bar code as required by claims 1, 11 and 15-17 and 19, it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have manufacture the bar codes of Bail as a two or three dimensional bar code for the purpose of holding varying amounts of information and since the examiner takes official notice that such bar code construction is well known in the art. Furthermore, the specific bar code dimensionality is considered to be a design choice in that applicants disclose that the bar code used in their invention may be of any type desired (page12, lines 12-14 and page 18, lines 6-8).

Response to Arguments

Applicant's arguments filed 1/20/2006 have been fully considered but they are not persuasive. Applicants argue that the combination of Lemelson and Swartz is improper since one would have to change the scanner of Lemelson to the scanner of Swartz if the bar code of Lemelson was changed to the bar code of Swartz where the scanner of Swartz is a non-contact type of scanner. In response the examiner points out that Lemelson already teaches a contact type scanner (see above rejection), furthermore Lemelson is silent as to the type of bar code utilized by his invention (i.e. one dimensional, two-dimensional or three-dimensional). Swartz is simply relied upon to provide a clear teaching of the use of a 2-D bar code with a system (in an environment

like that of Lemelson) designed to provide an audio response to the information carried by the bar code. The examiner is only proposing that the bar code of Lemelson be provided in a 2-D manner not that the scanner unit be changed to the unit of Swartz. Furthermore, the specific bar code dimensionality is *NOT CONSIDERED TO BE PATENTABLE SUBJECT MATTER* since it is considered to be merely a design choice in that applicants clearly disclose that the bar code used in their invention may be of any type desired including one dimensional (page 12, lines 12-14 and page 18, lines 6-8).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dmitry Suhol
Primary Examiner
Art Unit 3725

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